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PAUL H GINSBURG
PFIZER INC
235 EAST 42ND STREET 20TH FLOOR
NEW YORK NY 10017-5755

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OFFICE OF PETITIONS

In re Application of
Sobolov-Jaynes :
Application No. 09/707,320 : ON PETITION
Filed: 7 November, 2000 :
Attorney Docket No. 17685 (PC10408A) :

This is a decision on the renewed petition filed on 18 November, 2004 (as reflected in Office financial records), to revive the above-identified application under 37 C.F.R. §1.137(b) as abandoned due to unintentional delay.

The Office regrets the delay in addressing this matter, however, the papers appear never to have been matched with the file.

For the reasons set forth below, the petition under 37 C.F.R. §1.137(b) is **GRANTED**.

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the final Office action mailed on 24 September, 2002, with a reply due, absent a request and fee for extension of time, on or 24 December, 2002;

- Petitioner filed an after final communication–which was not a proper reply[1] to the final Office action–(with request and fee for extension of time) on 28 March, 2003, over a 24 March Certificate of Mailing;

- the application went abandoned by operation of law after midnight 24 March, 2003;

- the Examiner mailed an Advisory Action on 7 May, 2003;

- the Office mailed a Notice of Abandonment on 20 May, 2003;

- with the original petition, fee and statement of unintentional delay, Petitioner filed a continuation application cover sheet with fee authorization rather than a Request for Continued Examination (RCE) with fee and submission under 37 C.F.R. §1.114, and so the petition was dismissed on 18 June, 2004;

- with the instant petition (and fee), Petitioner also filed a reply in the form of a Notice of Appeal and fee authorization (fees having been charged prior to this writing), and made the statement of unintentional delay.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).[2]

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on

[1] The proper response to the final Office action (see: MPEP 711.03(c)) must be in the form of: (a) an amendment *prima facie* placing the application in condition for allowance; (b) a Notice of Appeal; or (c) a Continuing Application or Request for Continued Examination (RCE) (with fee and submission) under 37 C.F.R. §1.114.

[2] 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

petition.[3] Delays in responding properly raise the question whether delays are unavoidable.[4] Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[5]

And the Petitioner must be diligent in attending to the matter.[6] Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care. By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[7]

The record (including the petitions filed on 1 June and 18 November, 2004) does not necessitate a finding that the delay between midnight 24 March, 2003 (date of abandonment), and 18 November, 2004 (date of filing of grantable petition), was not unintentional.

Rather, the Patent and Trademark Office is relying in this matter on duty of candor and good faith of Petitioner/Counsel (Edward Groilz) (Reg. No. 33,705) when accepting Petitioner's representation that the delay in filing the response was unintentional.[8]

Petitioner has satisfied the requirements of 37 C.F.R.§1.137(b).

CONCLUSION

Therefore, the instant petition under 37 C.F.R. §1.137(b) hereby is **granted**.

Petitioner has two months from the mail date of this decision to file the Appeal Brief in triplicate and fee. Extensions of time are governed by the regulations at 37 C.F.R. §1.136.

[3] Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

[4] See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

[5] See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

[6] See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

[7] Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

[8] See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. §1.137(b) to the Patent and Trademark Office).

The instant application is released to Technology Center 1600 to await the filing of the Appeal Brief and fee by Petitioners, pursuant to the regulations at 37 C.F.R. §1.192.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions